

REMARKS

Summarizing this amendment, claim 20 has been amended, whereas the other claims remain unchanged. Thus, claims 1-12 and 19-29 are again presented for the examiner's consideration.

All of the claims are directed to a portable facility for reconditioning an antifriction bearing – a bearing that by its very nature comprises a multitude of components including races and rolling elements that roll along raceways on the races. The examiner rejected all claims under 35 USC 103, asserting that they described a facility for reconditioning bearings that is obvious in view of U.S. patent 3,308,845 (Bellas). That patent discloses a Mobile Service Station Unit for performing minor services and repairs on automobiles. The services include refueling, lubrication, oil changes, state safety inspections, whereas the repairs include replacing batteries, spark plugs, tires, and windshield wiper blades (col. 1, lines 49-55). The unit includes storage compartments that contain maintenance tools and spare parts required for the repairs and containers for lubricants, gasoline and antifreeze. (col. 4, lines 23-36). It also includes, within its interior, a lift for elevating an automobile to facilitate certain services and repairs. Whatever it has, the Bellas unit does not have equipment for reconditioning bearings, nor does it have spare bearing components. Indeed, the Bellas patent has nothing whatsoever to do with bearings.

The examiner must establish a prima facie case of obviousness and must factually support any conclusion of prima facie obviousness. Here the examiner relies on the Bellas patent to establish that prima facie case. But to do so the Bellas patent must provide some suggestion or motivation to modify it – essentially to convert it from an automobile service unit to a facility for reconditioning bearings. Secondly, there must be a reasonable expectation of success. Finally, the Bellas patent must teach or suggest all the limitations in the claims. See MPEP 2142.

The effort to establish a prima facie case of obviousness fails as to all three criteria. The Bellas patent has nothing whatsoever to do with bearings, much less reconditioning bearings and therefore would not motivate one of ordinary skill in the art of bearing manufacture and maintenance to consider it. Surely, one of ordinary skill would not succeed converting an automobile repair unit into a bearing reconditioning facility. The differences in the end to be achieved and the equipment to achieve that end are far too great to expect any success. Finally, one cannot find components such as spare races and rolling elements in the Bellas patent, much less practically all of the equipment set forth in the claims. The Bellas patent does not render obvious applicant's portable facility as set forth in the claims.

While compelling reasons exist for allowing independent claims 1 and 8 and the claims that depend from the, the reasons for allowing independent claim 20, as

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amended, and the claims which depend from it are even more compelling. Those claims call for a facility for reconditioning railroad bearings or as the claim 20 specifies, a bearing that was used on the journal of an axle for a railcar or locomotive. Surely, one engaged in the very specialized field of reconditioning railroad bearings would not turn to automotive service facilities for inspiration.

Applicant asked Rudolf Karich, an individual possessing considerable knowledge and experience in the field of reconditioning antifriction bearings, to consider the examiner's rejection of the claims. To this end Mr. Karich had before him the application, the claims that the examiner rejected, the official action containing the rejection, and the Bellas patent on which the rejection is founded. Mr. Karich disagrees with the examiner's evaluation of the claims and the pertinence of the Bellas patent. For one, he does not perceive one having ordinary skill in the art of reconditioning bearings turning to the Bellas patent for inspiration. Secondly, he does not consider the portable facility set forth in the claims to be obvious in view of the Bellas patent. Mr. Karich's reasoning and opinions appear in his declaration under 37 CFR 1.132 which is submitted herewith.

The examiner cites In re Aller and In re Mills, presumably to justify the application of the unrelated Bellas patent to the claims. In re Aller found obviousness in the chemical process that differed from a similar prior art process by a lower temperature

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and a higher sulfuric acid concentration. Applicant fails to see how that authorizes the use of the Bellas patent here. In re Mills does not appear at the citation given and applicant could not locate it.

In view of the foregoing, favorable consideration and allowance of the application with 23 claims – namely, claims 1-12 and 19-29 – are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Edward A. Boeschstein". The signature is fluid and cursive, with a prominent "E" and "B".

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